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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/073,748

05/06/1998

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119645-00103.12

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64574

7590

01/07/2009

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EXAMINER

COLBERT, ELLA

ART UNIT

PAPER NUMBER

3696

MAIL DATE

DELIVERY MODE

01/07/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/073,748	<b>Applicant(s)</b> WEISSMAN ET AL.	
	<b>Examiner</b> Ella Colbert	<b>Art Unit</b> 3696	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 133, 134, 136-142, 144-150 and 152-189 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 133, 134, 136-142, 144-150 and 152-189 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/27/08</u> .   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

Claims 133, 134, 136-142, 144-150, and 152-189 are pending. Claims 133, 140, 141, 148, 149, and 156 have been amended in this communication filed 10/10/08 entered as Response After Non-Final Action and Request for Extension of Time.

The IDS file 8/27/08 has been entered and considered.

The 35 USC 112, second paragraph rejection in the prior Office Action have been partially overcome for claims 133, 134, 136-138, 140-143, 144-146, 148-150, 152-154, 156-172, 174-179, 181-186, 188, and 189 and are hereby withdrawn in part. Claims 133, 140, 141, 148, 149, 156, 163, 166, and the claims that depend from these claims still remain rejected under 35 USC 112, second paragraph for issues as set forth here below.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 133, 134, 136-138, 140-142, 144-146, 148-150, 152-154, 156-172, 174-179, 181-186, 188, and 189 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 133 recites “providing a metadata system that includes a metadata schema, a facility for entering instructions into the metadata schema, and ...”; Receiving instructions including semantic definitions from a user, wherein the instructions including semantic definitions ....; and generating the business database system automatically using the semantic definitions of the instructions ...”. It is unclear, vague, and indefinite as to what “instructions” are being referenced. Do Applicants’ mean “instructions for generating one or more database systems” or something else?

Claim 134 recites “generating tables automatically according to the instructions”. This claim limitation is unclear, vague, and indefinite because it cannot be determined what instructions are being referenced. Do Applicants’ mean the “instructions are semantic definitions” or something else? Claims 136-138, 140-142, 144-146, 148-150, 152-154, 156-172, 174-179, 181-186, 188, and 189 have a similar problem.

Applicants’ are respectfully requested to point out where a business database system is found in the specification. There is nothing found in the specification that references a business database system. There are elements that might suggest a business database system but nothing specific referencing a business database system as such.

“An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed ...”. *In re Zletz* 13 USPQ2d 1320 (Fed. Cir. 1989).

***Specification***

The specification is objected to because on page 11, line 10, reciting “are set up, arid a query mechanism is generated”. It is unclear whether the term “arid” is supposed to be in that sentence or did Applicants’ mean something else?. Correction is required. See MPEP § 608.01(b).

***Allowable Subject Matter***

The following is a statement of reasons for the indication of allowable subject matter: Applicants’ method for “generating the business database system automatically using the semantic definitions, whereby the business database system is well-formed in claims 133, 140, 141, 148, 149, 156, 163, and 166 and computer system, and computer readable storage medium for “automatically generating the business database system using the semantic definitions, whereby the business database system is well-formed” in claims 141, 148, 149, and 156 with the other claim limitations would be allowable once the claim objections are overcome and the claim rejection for claim 166 is resolved and if there is no new art found to reject the claims after an updated search has been performed.

Conclusion: The Examiner apologizes for the delay in issuing the application.

However, these issues need to be resolved prior to issue of the application.

### ***Response to Arguments***

Applicant's arguments filed 10/10/08 have been fully considered but they are not persuasive.

Issue no. 1: Applicants' argue: Applicants' have amended claims 133, 140, 141, 148, 149, and 156 to precisely recited the Examiner's allowable claim limitation has been considered and is acknowledged.

Issue no. 2: Applicants' argue: The Examiner rejects claim 133 as being unclear, vague, and indefinite as to what "instructions" are being referenced in the claim and the Examiner inquires whether the Applicants' are referring to instructions for generating one or more database systems or something else". Appreciation of the specification and claims, "instructions" as used in the application refers to a "single operation" executed by a computer has been considered with the other references to "instructions" but is not considered persuasive. Response: In response to applicants' argument that the references fail to show certain features of applicants invention, it is noted that the features upon which applicant relies (i.e., "instructions" are a "single operation") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore, the referenced sections of the specification on page 14 lines 12 through 21 and page 20

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lines 8 through 20 do not mention "instructions" or the creation of a "business database system". These ("instructions" and "business database system" are left to interpretation and not what is disclosed in the specification.

Also, claim 134 is rejected as being unclear, vague, and indefinite as to what "instructions" are being referenced in the claim and the Examiner inquired as to whether the Applicants' are referring to "semantic definitions or something else". Again Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Furthermore, it is unclear, vague, and indefinite where these instructions are coming from. Are they being received from a computer or a user or from something else?

Issue no. 3: Applicants' argue: Applicants' respectfully submit a business database system is well defined throughout the specification and specifically, a system 100 is well defined and explained in Figure 1 and on pages 13 through 20 has been considered but is not persuasive. Response: Pages 13 through 20 and Figure 1 referenced only a suggested "business database system" but there is nothing that says in Figure 1, 100 that this is a business database system. The drawing figure and page 13 references "100" as "a system". This could be any system because the term "system" is very broad and varied.

Also, the Examiner does not find in the specification or drawings a "computer readable storage medium encoded with software instructions wherein execution of the

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instructions perform the functions of claims 149 and 156. Applicants' are respectfully requested to point out in the specification where a "computer readable storage medium encoded with software instructions wherein execution of the instructions" can be found.

**Suggestions:** Since there are so many method, system, and computer readable storage medium claims that are so similar to each other, the Applicants' should consider adding the claim limitations to the other independent claims that are so similar.

For example, claim 133 recites "... comprising: providing a metadata system that includes a metadata schema, a facility for entering instructions into the metadata schema, and a facility for manipulating the metadata schema; receiving instructions including semantic definitions from a user, wherein the instructions including semantic definitions are entered into the metadata schema and are used to create a business database system; and generating the business database system automatically using the semantic definitions whereby the business database system is well-formed". Claim 140 is very similar to this independent claim and some of the limitations from claim 140 could be incorporated into claim 133. The other dependent claims could depend from claim 133 and so on or some of the dependent claim limitations could be rolled into the independent claims. Independent claims 156, 163, and 166 do not have enough claim limitations for an independent claim. Claim 166, especially does not have enough steps for an independent claim. Applicants' might consider making independent claim 163 into a dependent claim.



“An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed ...”. *In re Zletz* 13 USPQ2d 1320 (Fed. Cir. 1989).

“We are not persuaded by any sound reason why, at any time before the patent is granted, an applicant should have limitations of the specification read into a claim where no express statement of the limitation is included in the claim ... However, this court has consistently taken the tack that claims yet unpatented are to be given the broadest reasonable interpretation consistent with the specification during the examination of a patent application since the applicant may then amend his claims, the thought being to reduce the possibility that, after the patent is granted, the claims may be interpreted as giving broader coverage than is justified.” *In re Prater*, 162 USPQ 541 (CCPA 1969).

“Claims in a pending application should be given their broadest possible interpretation”. *In re Pearson*, 181 USPQ 641 (CCPA 1974).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### **Inquiries**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Monday, Tuesday, and Thursday, 5:30AM-3:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dixon Thomas can be reached on 571-272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

January 4, 2009

/Ella Colbert/

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Primary Examiner, Art Unit 3696